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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,544	02/06/2001	Thomas Dietz	14186	7213
23389	7590	07/13/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,544

Applicant(s)

DIETZ ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9,12,13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,12,13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Receipt of applicants' amendments, exhibit, and remarks submitted April 30, 2004 is acknowledged.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 12, 13, 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cauwet-Madin (US Pat. 6,488,780 B2).

The instant claims 1-9 are directed to emulsions which are free of silicone oil and comprise polyether siloxanes of formula (1). The instant claims 12, 13, 15 and 16 are directed to a process for preparing such emulsions. And claims 17-23 are directed to emulsions which comprise 10% by weight or Less of alcohol and at least one polyether siloxane of formula (1). Additional cosmetic or pharmaceutical components are claimed in the dependent claims.

Cauwet-Martin teaches detergent cosmetic compositions. The compositions comprise a washing base and a conditioning system with an oil nanoemulsion, wherein the oil droplets is less than 150 nm (see abstract, col. 1, lines 52-64). The washing base is generally aqueous (see col. 2, lines 29-31). The reference teaches that the aqueous medium can be composed solely of water or a mixture of water and a lower alcohol such as ethanol (see col. 11, lines 11-17). The conditioning system comprises at least one non-ionic amphiphilic lipid, which is preferably

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chosen from polyether siloxanes (see col. 5, lines 25-50; and claims 13 and 15). Suitable oils for the emulsion include animal or vegetable oils (see col. 10, Lines 24-57). Additional co-emulsifiers are taught under the category of ionic amphiphilic lipids (see col. 6, Line 24 through col. 10, line 23). Weight percentages are taught (see col. 10, lines 19-23). Stearic acid is particularly mentioned as a possible component (see col. 3, lines 5-7). Additional active ingredients are taught (See col. 10, line 60 through col. 11, line 2). While all of the claimed limitations are taught by Cauwet-Martin, the reference lacks disclosed examples of the exact same scope as the instant claims. The reference is not anticipatory as it requires some "picking and choosing" to arrive at the claimed compositions and methods.

It would have been obvious to one of ordinary skill in the art to have modified the compositions and methods of Cauwet-Madin by the selection of various components taught therein in order to arrive at cosmetically acceptable compositions. For example, in arriving at a composition that is "free of silicone oils" as claimed, it would be necessary to omit silicone oils from the compositions of Cauwet-Madin. While Cauwet-Martin teaches that silicone oils can also be used in the oil phase (see col. 10, Lines 24-57), the reference does not teach or suggest that silicone oils are necessarily present in the compositions. The motivation for selecting various components taught by Cauwet-Madin is to arrive at a cosmetically acceptable composition.

Response to the Arguments

Applicants' amendments, exhibit, and remarks submitted April 30, 2004 have been fully considered, but are not persuasive for reasons discussed below.

Applicants' arguments and exhibits as to the definition of "emulsion" are not persuasive. Particularly, the exhibits provide more question than answer as to the concurrent definition of

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“emulsion,” “microemulsion,” “macroemulsion,” and “nanoemulsion” The reference 1 herein actually calls miniemulsion “macroemulsion containing very small droplets” (page 4 of reference 1). As to the particle size, reference 1 defines microemulsion with 1-10 nanometers and macroemulsion with micrometers. It is unclear where to put of those with particle size of 100 nanometers to 1 micrometer. (see page 5 of reference 1 of the exhibits). Further, there is no evidence showing the exhibits herein are accepted as art standard. Current dictionary definition of “emulsion” is “A system containing two immiscible liquids in which one is dispersed, in the form of very small globules (internal phase), throughout the other (external phase) (e.g., oil in water (milk) or water in oil (mayonnaise)).” (Stedman’s medical dictionary 27th Edition), thus read on the nanoemulsion disclosed by the cited reference.

2. In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., particle size) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. Further, applicants concede that the cited reference also made normal emulsion similar to those claimed herein, but shows the normal emulsion was unstable compared to nanoemulsion (pages 10-11 of the response). Even if applicants had claimed “macro emulsion” as defined in the arguments, absent material limitation that is critical making the emulsion stable, the “macro emulsion” would be obvious over the cited prior art. Note “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Allowable Subject Matters

Following subject matters are allowable base on the unexpected results disclosed in the specification, i.e., the employment of the particular silicone polyether surfactant to a particular emulsion composition provides more stable composition compared to similar composition with other surfactant: The emulsion compositions disclosed in examples 8 and 9, wherein the compositions are made by the process disclosed at pages 24 and 25 herein in the specification.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

SHENGJUN WANG
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'S. Wang' with a stylized flourish at the end.

Shengjun Wang

July 2, 2004